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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,220	02/20/2001	Noriko Sakai	1341.1081/JDH	3951

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EXAMINER
GART, MATTHEW S

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/785,220

Applicant(s)

SAKAI ET AL.

Examiner

Matthew s Gart

Art Unit

3625

*Handwritten signature*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 4-9 and 11-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Claim 4-9 and 11-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 02, 2004.

The traversal is on the ground(s) that "...there have been no reference cited to show any necessity for requiring restriction and, it is believed that the Examiner would find references containing claims directed to more than one of the groups delineated by the Examiner." This is not found persuasive because the Applicant has not demonstrated that the Examiner's grouping was in error, or that the groups are not patentably distinct. The applicant must present evidence or identify such evidence of record showing the groups to be obvious variations of one another. The Applicant merely stated that it could be possible to find a reference that contains teachings directed to multiple groups. The Examiner notes, the fact that groups may be searched together cannot preclude a requirement for restriction if their appearances are considered patentably distinct.

The requirement is still deemed proper and is therefore made FINAL.

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Rejections - 35 USC §101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. "A gift mediating method for mediating a gift to be presented from a sender to a receiver, etc." mere nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not affect or affect the underlying process.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee U.S. Patent Application Publication 2002/0032605.**

Referring to claim 1. Lee discloses a gift mediating method for mediating a gift to be presented from a sender to a receiver, the method comprising:

A receiver corresponding step of providing the gift order information sent from the sender of the gift to a receiver-side client set to the receiver side of the gift (paragraph 0002);

A gift changing step of storing the gift change for change of the gift sent from the receiver-side client (paragraph 0002); and

A sender corresponding step of providing the gift change information corresponding to the receiver to the sender-side client when the sender-side client set to the sender side executes gift-order processing for the receiver (paragraph 0028).

Lee discloses a method for providing a gift certificate to a recipient (receiver corresponding step), and more particularly, to a method that enables a user of an addressable website to purchase a first gift certificate which is redeemable by a recipient for a second (gift changing step), recipient-selectable gift certificate. Processor **108** of Lee is also coupled to database **120**, which, according to one embodiment, is configured to store data corresponding to purchasers, recipients, merchants and the various gift certificates that have been purchased. And finally the sender can provide a gift certificate to the receiver tailored to the recipient's taste utilizing knowledge stored in database **120** (paragraph 0054).

Referring to claim 10. Claim 10 is rejected under the same rationale as set forth above in claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee U.S. Patent Application Publication 2002/0032605 in view of Official Notice.**

Referring to claims 2 and 3. A gift mediating method wherein the sender corresponding step provides the information of a tailored gift suitable for at least the receiver to the sender-side client when the gift is ordered in accordance with the gift change information (paragraph 0054).

Lee does not expressly disclose the use of recommending a best gift or a worst gift suitable for at least the receiver. The Examiner takes Official Notice, that the recommendation of a best gift or a worst gift suitable for at least the receiver is functionally equivalent to the method as indicated in Lee. In both cases the sender is attempting to find a suitable gift for the receiver.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Lee to have included the recommendation of a best gift or a worst gift suitable for at least the receiver in order to demonstrate to the recipient that the sender has made an effort to provide a gift certificate tailored to the recipient's taste, without limiting the recipient's choice of redemption to only a single merchant (paragraph 0054).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dodd, U.S. Patent No. 6,321,211 B1, November 20, 2001, discloses a method and system for electronically accepting and exchanging an online gift.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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A handwritten signature in black ink, appearing to be 'M. J.' or similar, written in a cursive style.

MSG

Patent Examiner

November 30, 2004